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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/611,918

Filing Date: July 03, 2003

Appellant(s): IGARASHI ET AL.

James A Oliff
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 8, 2010 appealing from the Office action mailed November 18, 2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claim 5 is rejected and is pending in the application.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

JP 64-016346	SATORU	01-1989
5,053,971	WOOD ET AL	10-1991

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 5 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 as amended recites for rows to include a first division for each number of revolutions of the lens, corresponding to the type of material, whereas specification as originally filed, e.g., in paragraph 0170, describe for the column to include these data, further Fig. 24 indicates for the rows to show the type of machining, e.g., circumferential surface rough machining, fine machining, etc., whereas claims as amended now recite for the columns to indicate these values. Since the claim and appellant's specification appear to contradict one another, it is not clear as to the metes and bounds of the claim.

Further with regards to claim 5, the recitation that a number of revolutions of the plastic lens is calculated based on... renders the claim indefinite. Specification as

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originally filed defines "setting" values like feed speed, tool, speed, number of revolution of the lens and by changing these parameters according to the material and power of the lens, the shape and size could be uniformly finished (see e.g., paragraph 165); and that by changing these parameters according to the type of machining, finished surfaces can be made in good fashion (paragraphs 166, 179). It is unclear what is being claimed by reciting the number...is calculated? Applicant is required to clarify and point out the support. Rejection under 112, first paragraph is not applied, at this time, since the deficiencies appear to be of clarity rather than enablement.

Claim 5 (as best understood) stands rejected under 35 U.S.C. 103(a) as being unpatentable over JP 64-016346.

JP'346 meets all of the limitations of claim 5, i.e., a method of rough machining and finish machining (see Abstract) in which cutting speed (revolution of lens as best understood), feed

	T1	T2	T3	...
W1	V—	V—	V—	...
W2	V—	V—	V—	...
W3	V—	V—	V—	...
⋮	⋮	⋮	⋮	⋮

	T1	T2	T3	...
W1	V—	V—	V—	...
W2	V—	V—	V—	...
W3	V—	V—	V—	...
⋮	⋮	⋮	⋮	⋮

amount (feed speed), and a material (e.g., plastic as commonly used in the art) to be machined are inputted to an NC device for different type of machining (rough and finish machining disclosed) and a table comprising rows and columns would indicate the cutting speed and a feed rate of the tool and a tool feed speed (i.e., lens holding shaft turning speed and thus the number of revolution of the workpiece or number of revolution of the plastic lens for a particular size and shape) for either or both rough and fine machining based on the inputted variables, except for explicitly disclosing groove

engraving and chamfering, considered to be obvious modifications to one of ordinary skill in the art for adapting the method and the table to output values for grooving and chamfering. The table as disclosed includes a column for the type of the work, e.g., a material to be cut (see Abstract), but it does not appear to disclose the thickness of the lens, however, one of ordinary skill in the art would have known that desired finish and/or rough machining would directly depend on the thickness of the work, or the amount to be abraded, therefore it would have been obvious to one of ordinary skill in the art to modify the table to further include the thickness of work in addition to the material to be cut in achieving the desired results, e.g., in abrading a plastic lens commonly used.

Claim 5 (as best understood) stands rejected under 35 U.S.C. 103(a) as being unpatentable over JP 64-016346 in view of Woods (5,053,971).

JP'346 as described above meets all of the limitations of claim 5, except for disclosing groove engraving and chamfering and the thickness of the lens. Woods teaches chamfering or beveling lens in which proper speed and feed rate are set based on the material selected (10:28) and thickness (04:45-55). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of JP'346 with additional variables, e.g., thickness as taught by Woods to adapt the method for operations like chamfering, grooving, etc.

(10) Response to Argument

With regards to the 112, 2nd paragraph rejections of the claim, Appellant argues that firstly Fig. 24 describes and clearly defines the columns and rows as recited and

that secondly, Fig. 25 and pages 69-71 clearly define the claim recitation of calculating a number of revolutions of the plastic lens. The claim language does not clearly set the scope of the claim. Claim 5 recites for the table to include a turning speed of the tool defined in the specification, e.g., paragraph 169, as "cutter turning speed=tool turning speed"; the turning speed of the held lens, defined in the specification, e.g., paragraph 169, as "lens holding shaft turning speed=feed speed"; and a number of revolution of the lens defined in the specification, e.g., paragraph 164, as "=number of cutting (edging) turns" rendering the claim indefinite, since firstly the table as disclosed in Fig. 24 and described in paragraph 169 only lists the tool turning speed and the feed speed; and secondly the number of revolution of the lens (as best understood) would depend on the turning speed of the lens (feed speed) and the size/shape of the lens. The claim does not set forth the size and the shape of the lens rendering this limitation unclear. Appellant has argued that Fig. 24 shows a turning speed of the revolving machining tool (e.g., Tool Turning Speed), with rows indicating the turning speed of the lens held (e.g., lens shaft turning speed); however, this is not persuasive, since claim 5, in lines 10-13, recites for a table "including a turning speed of the revolving machining tool, a turning speed of the held plastic lens and a number of revolution of the plastic lens", therefor if Tool Turning Speed indicates the turning speed of the revolving machine tool, and Lens Shaft Turning Speed indicates the turning speed of the lens held, what then, indicates the a number of revolution of the plastic lens in Fig. 24? Appellant further indicates that rows have a first division (annotated Fig. 24) that indicate thickness of the plastic lens (e.g., Thick, Thin), which is not persuasive, since Thick or Thin does not indicate a

thickness; further Thick and Thin define columns and not rows. It seems that Appellant argues with regard to the rejection of claims under 112, second paragraph that the rejection appears to be (or should have been) of enablement and that examiner gives no reasons as to why the claim is indefinite. This argument is in error, since claim 5 has been amended to read over prior art applied, and claim recites features not clearly defined neither by the specification as originally filed nor in the claim as recited, and as was indicated in the prior office actions, the deficiencies appear to be of clarity and not of enablement. Appellant's explanation of how columns and rows meet the recited features and/or how column and rows may be defined, does not overcome the deficiencies. Appellant further argues that specification indicates that the number of revolutions of a plastic lens, "y", can be calculated, whereas the claim recites, in lines 10-13, to forcibly edging... by "reading" and "using" a parameter of each machining condition, including a number of revolution of plastic lens, from a table previously prepared and then recites in lines 26 and 27 to "calculate" a number of revolution of the plastic lens. The claim as recited is considered by the examiner to be indefinite for failing to clearly recite the elements and features being claimed.

With regards to the obviousness rejections of the claim, Appellant argues that Satoru does not support the assertion that a skilled artisan would have known that a desired machining would depend on the thickness of the work; and that Wood et al (teaching reference) merely discloses verifying that there would be sufficient thickness to permit beveling. The argument that an artisan practicing in the art of machining, i.e., grinding (rough and/or fine), beveling, grooving, chamfering, etc., would not be aware

that a desired machining (i.e., desired finish, e.g., fine machining left with a particular dimension) would depend on the thickness (or material or other variables of the workpiece) is error. A desired finish would depend on the variables or parameters of the workpiece, including a thickness of the lens. However, the arguments are invalid, because, firstly appellant is reading more into the claim than recited and secondly because the indefinite scope of the claim, as best understood, is met by JP'346 either alone or in view of Wood; even if Wood is considered as disclosing only verification of the thickness. Claims recite for a lens machining method positively reciting for machining a plastic lens including rough machining and finishing machining by reading and using a parameter of each machining condition including a turning speed of the tool, a turning speed of the lens and a number of revolution of the lens based on a table previously prepared, which is met by JP' 346 as modified alone or in view of Wood, then the claim appears to recite for obtaining the number of revolution of the lens by calculating it based on the material and thickness and other variables. JP'346 in the abstract discloses that a table reads the cutting speed and a feed speed for either or both rough machining and finished machining according to a combination of a using tool, inputted according to a machining kind and a material to be cut; based on the read data, the number of revolution is determined, meeting the claim as best understood, except for disclosing particular parameters, e.g., table used for edging (chamfering...), providing specific data for a particular application would have been obvious to one of ordinary skill in the art within KSR reasoning, as it would have only required, e.g., combining prior art elements according to known methods to yield predictable results. In

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this case the use of thickness of the material to calculate the number of revolution renders the claim indefinite as indicated above for at least being contrary to an earlier recitation, wherein the number is provided, however, in the alternative, providing the table with such variable is considered to the examiner to be within the routine experimentations. With regards to the combination of JP'346 and Wood, it is firstly noted that Wood disclose that the local edge thickness of the lens is determined and is utilized in the instruction set in the software program of the controller, column 4, lines 35-50, thus, in the alternative, providing the table with a variable indicating the thickness, even if it is used to only verify sufficient thickness as argued by the Appellant, would meet the claim as best understood, i.e., a table including a number of revolution wherein the number is calculated based on the material and thickness.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Hadi Shakeri/
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/Monica S. Carter/

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